

Amendment and Response
Applicants: John C. Oslund et al.
Serial No.: 10/823,139

Attorney Docket: ev31010USD1

REMARKS

Claims 1 to 19, 29 to 31, 56 to 59, and 61 to 70 were pending. Claims 19 and 29 have been canceled without prejudice above. After entry of this amendment, claims 1 to 18, 30, 31, 56 to 59, and 61 to 70 will be pending and under examination.

On page two of the July 28, 2005 Office Action, the Examiner states that claim 19 is withdrawn from further consideration as being drawn to a non-elected invention. This appears to be a typographical error. Applicants believe that claim 29 was withdrawn from consideration. Both claims 19 and 29 have been canceled above.

The Examiner rejected claims 1 to 13, 16 to 19, 30, 31, 56 to 59 and 61 to 70 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,814,064 to Daniel et al. ("Daniel '064").

Applicants respectfully traverse this rejection of the claims. Claim 1 recites "a self-expanding radial member associated with said filter basket". Daniel '064 does not teach or suggest a self-expanding radial member. The Examiner states that "Daniel teaches a distal protection device comprising a filter basket 18 having closed distal end and an open proximal end; a self expanding radial member 20 associated with the filter basket in proximity to the proximal end thereof" Page two of the July 28, 2005 Office Action. However, inflatable member 20 of Daniel '064 is not self expanding. The inflatable member 20 must be inflated to expand. The Daniel '064 patent states:

The syringe is used to pressurize the fluid such that fluid is introduced through the lumen of hollow guidewire 14, through valve 24, and into inflatable member 20. Upon being inflated, inflatable member 20 expands radially outwardly from the outer surface of

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guidewire 14 and carries mesh 22 into the deployed position shown in FIG. 1.

Column 3, lines 51 to 57.

Accordingly, Daniel '064 does not teach or suggest the self-expanding radial member recited in claim 1. Claims 2 to 13, 16 to 18, 30, 31, and 56 to 58 depend from claim 1 so the same analysis applies to these claims. Claims 59 and 61 both recite "a generally radially self-expanding member" so the same analysis applies to these claims. Claim 19 has been canceled above.

Claims 62, 65, and 68 recite a distal protection device comprising, in part: (1) "a guidewire"; (2) "a tube sized to receive the guidewire"; and (3) "a filter basket connected to the tube". Daniel '064 does not teach or suggest a distal protection device having these three elements.

The Examiner describes Daniel '064 as showing a "filter basket includ[ing] a tube through which the guidewire extends (the filter basket is configured as a tube in which the guidewire extents therethrough)" Pages two and three of the July 28, 2005 Office Action. However, capture assembly 18 of Daniel '064 cannot be both the claimed filter basket and the tube. Daniel '064 illustrates a protection device 10 in FIG. 1. Capture assembly 18 is mounted on hollow guidewire 14. If the capture assembly 18 is considered to be the claimed filter basket and the hollow guidewire 14 is considered to be the claimed guidewire, then Daniel '064 does not teach or suggest the addition of the claimed tube sized to receive a guidewire. On the other hand, if the capture assembly 18 is considered to be the claimed tube sized to receive the guidewire (which Applicants do not concede to be a reasonable construction of Daniel '064) and the hollow guidewire 14 is considered to be the claimed guidewire, then Daniel '064 does not teach or suggest the addition of the claimed filter basket connected to the tube. Daniel '046 does not teach or suggest attaching a second filter basket to the

Amendment and Response
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capture assembly 18. Accordingly, Daniel '064 does not teach or suggest a distal protection device comprising, in part: (1) "a guidewire"; (2) "a tube sized to receive the guidewire"; and (3) "a filter basket connected to the tube", as recited in claims 62, 65, and 68. Claims 63, 64, 66, 67, 69, and 70 depend from these claims so the same analysis applies to these claims.

As detailed above, Daniel '064 does not teach or suggest the subject matter of claims 1 to 13, 16 to 18, 30, 31, 56 to 59, and 61 to 70. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection of the claims.

The Examiner rejected claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over the combination of Daniel '064 and U.S. Patent No. 6,001,118 to Daniel et al. ("Daniel '118").

Applicants respectfully traverse this rejection of the claims. Claims 14 and 15 depend from claim 1 which has been discussed above. The above analysis regarding claim 1 also applies to dependent claims 14 and 15. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection of the claims.

The Examiner rejected claims 1 to 18, 30, 31, and 62 to 70 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 to 32 of U.S. Patent No. 6,740,061 B1.

In response to this rejection, Applicants enclose a terminal disclaimer over U.S. Patent No. 6,740,061 B1. Accordingly, Applicants respectfully request that the Examiner withdraw this rejection of the claims.

The July 28, 2005 Office Action included some PTO-1449 forms that were signed by the Examiner. The Office Action did not include a signed copy of the PTO-1449 form included with the March 29, 2005 Supplemental Information

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Disclosure Statement. Applicants respectfully request that the Examiner sign and return this PTO-1449 form to Applicants' representatives.

In view of the above amendments and remarks, Applicants respectfully request that the Examiner withdraw the rejections of the claims.

If any additional fees are due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

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By 

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